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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------|------------------|
| 10/001,363   | 10/25/2001  | John Steffen         | PG16044P0221US         | 2326             |
| 7590 07/09/2004<br>WOOD, PHILLIPS, KATZ, CLARK & MORTIMER<br>500 WEST MADISON STREET<br>SUITE 3800<br>CHICAGO, IL 60661-2511 |             |                      | EXAMINER<br>LEE, RIP A |                  |
|  |             |                      | ART UNIT<br>1713       | PAPER NUMBER     |
| DATE MAILED: 07/09/2004  |             |                      |                        |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/001,363

Applicant(s)

STEFFEN ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 8, 13 and 14 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8, 13 and 14 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to wetting agents, classified in class 524, subclass 585.
  - II. Claims 8, 13, and 14 drawn to an absorbent article, classified in class 604, subclass 378.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different functions. The wetting agent may be used for treating individual nylon fiber or it may serve as a color concentrate for molding compositions. Clearly, the wetting agent has different function and different effects compared with an absorbent article.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Stephen D. Geimer on June 14, 2002, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8, 13, and 14 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1, 3, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,668,172 to Jones *et al.*

Jones *et al.* discloses a concentrate comprised of 250 lb of polyethylene, 250 lb of TiO<sub>2</sub>, 100 lb of mineral spirits, and 10 lb of alkyl diethylene oxide amine acetate surfactant (example 4). Once processed (see Example 1), the concentrate contains 40 % TiO<sub>2</sub>, 1.6 % surfactant, and the balance is carrier resin. The terms surfactant and wetting agent are synonymous, and in this case, the surfactant functions adequately as wetting agent. Mineral spirits, being non-reactive, would not materially affect the basic and novel characteristics of the claimed invention, and therefore, the compositional requirements set forth in the claims is met. The concentrate is applied to polyester compositions which can be fabricated into a film (col. 3, lines 29-31). As such, the subject matter of the present claims is anticipated by Jones *et al.*

10. Claims 1 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,051,618 to Tabaksblat *et al.*

The prior art of Tabaksblat *et al.* relates to the manufacture of polymer particles which can be used as concentrates and carriers for substances to be released at a slow or controlled rate (col. 6, lines 61-65). In example 1, such a carrier is comprised of 45 g of low density polyethylene (LDPE), 0.38 g of nucleating agent, and 0.63 g surfactant (wetting agent). This translates to 1.4 wt % of surfactant. The nucleating agent is non-reactive, and therefore, it does not materially affect the basic and novel characteristics of the claimed invention, and therefore, the compositional requirements set forth in the claims is met.

11. Claims 1, 2, 4, 6, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,410,823 to Daley *et al.*

Daley *et al.* discloses a concentrate made of 90 wt % Rexene 1058 (an LDPE resin)<sup>†</sup> with 10 wt % Ahcovel Base N-62 and Masil SF-19 surfactants (Example 1, col. 6, lines 34-37). These are blended with additional resins and used to form melt-extruded cast films (col. 6, lines 41-45). These apertured films are then thermally bonded to a nonwoven web (Example 2, col. 8, lines 1-3).

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<sup>†</sup> See U.S. Patent No. 6,190,758 (col. 10, line 5); U.S. Patent No. 6,303,062 (col. 13, lines 8 and 10).

12. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,607,341 to Goins *et al.*

Goins *et al.* discloses a composition for treating fabric comprising 100 parts by weight of base resin, 3.5 pw of surfactant, and 15 pw of TiO<sub>2</sub> (example II).

***Allowable Subject Matter***

13. The following is a statement of reasons for the indication of allowable subject matter: Claim 5 is allowable over the cited prior art. The closest references are Jones *et al.* and Goins *et al.*, however none of these patents suggests the claimed composition consisting essentially of about 12.5 wt % wetting agent, about 40 wt % TiO<sub>2</sub>, and about 47.5 wt % of LDPE. One having ordinary skill in the art would not have found it obvious to modify the teachings of the prior art to arrive at the present claims, and there is no motivation to combine references to arrive at the subject matter of the instant claim.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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June 24, 2004



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